



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/837,852      | 04/18/2001  | Brian Mark Shuster   | 409475-27           | 9134             |

23879 7590 02/08/2005

BRIAN M BERLINER, ESQ  
O'MELVENY & MYERS, LLP  
400 SOUTH HOPE STREET  
LOS ANGELES, CA 90071-2899

|          |
|----------|
| EXAMINER |
|----------|

SMITH, JEFFREY A

|          |              |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

3625

DATE MAILED: 02/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/837,852

**Applicant(s)**

SHUSTER, BRIAN MARK

**Examiner**

Jeffrey A. Smith

**Art Unit**

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

Art Unit: 3625

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-5, 8-14, and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Oliphant et al. (US 2001/0025256 A1).

Oliphant et al. discloses a method and computer-implemented system for managing virtual properties that exist solely in a virtual form within a computer network and that have no physical counterparts (par. 00008). An inventory of virtual property is maintained in a centralized database accessible by a user via a network connection (par. 0014; par 0028). Ownership of said virtual properties are managed in said centralized database (par. 0036). A property owner is allowed use but not possession

Art Unit: 3625

of digital copies of said virtual properties within corresponding network systems (par. 0046). The Examiner notes that par. 0046 identifies an embodiment of the invention in which "the account may only provide the user with access to electronic works stored at the host 120 or one or more remote content locations 160". The Examiner additionally notes that such access may be by "streaming the work to the user location 180" (par. 0072). In this manner, the limitation regarding a property owner being allowed use but not possession of digital copies of said virtual properties is met.

Oliphant et al. discloses a search function (par. 0049). Note that the host location 120 itself is considered by Oliphant et al. to be a "content location" (par. 0028).

Virtual properties are associated with respective property owners via "accounts" (par. 0036; 0048; par. 0014).

A step of ownership transfer is managed. One example, is that a virtual property is purchased by a customer through an authorized retailer (par. 0065) and access is authorized based upon a confirmation number obtained from a retailer (par. 0014; 0036).

Partners are coordinated via said network to identify additional virtual properties not included in said inventory. The Examiner notes that the search function accepts a user's

Art Unit: 3625

direction for a virtual property and searches, not only the centralized database ("host") inventory, but also all other networked content locations 160 (par. 0049; par. 0052). One such content location may be "other websites" (par. 0016). Such websites are viewed, in Oliphant's paradigm, as being partner to the central database (or "host").

Oliphant et al. discloses that the system may be configured in a client-server architecture (par. 0028) and is internetworked (par. 0029).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 6, 7, 15, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oliphant et al. (US 2001/0025256 A1) in view of Martinez et al. (WO 98/47091).

Art Unit: 3625

Oliphant et al. discloses acquiring ownership in a virtual property via purchase of such virtual property (see discussion above). Oliphant et al. does not disclose either trading or winning virtual property.

Martinez et al., however, in a virtual environment supporting the use and transaction of virtual property (page 3, lines 1-11), teaches that virtual property may be sold, traded or won (see page 23, line 15-page 24, line 3).

It would have been obvious to one of ordinary skill in the art to have provided the method and system of Oliphant et al. to have included the trading and winning of virtual property in order to establish traditional features of ownership and property rights in a virtual realm (such as in the computer network of Oliphant et al.) (see Martinez et al. at page 2, lines 14-24).

#### ***Response to Arguments***

Applicant's arguments with respect to claims 1-17 have been considered but are moot in view of the new ground(s) of rejection.

**Conclusion**

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Drummond, Mike: "Tune Town | San Diego-based digital music provider emphasizes personal CD service", The San Diego Union-

Art Unit: 3625

Tribune, San Diego CA, April 4, 2000, pg. 6 discloses that access to virtual property may be provided without allowing possession of such property. In that regard, Drummond reports the following: "Like radio, songs are played back or 'streamed', rather than being stored on a computer's hard drive".

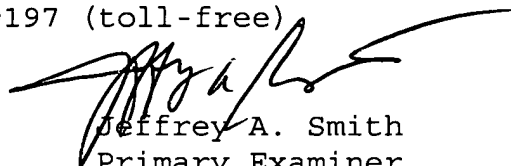
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey A. Smith whose telephone number is 703-308-3588. The examiner can normally be reached on M-F 6:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703-308-1344. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



Art Unit: 3625

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free)



Jeffrey A. Smith  
Primary Examiner  
Art Unit 3625

jas